



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,585	10/15/2003	Christian Almberg	010315-209	1749
21839 7590 01/24/2008 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER STEPHENS, JACQUELINE F	
			ART UNIT 3761	PAPER NUMBER
			NOTIFICATION DATE 01/24/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com
debra.hawkins@bipc.com

Office Action Summary	Application No. 10/684,585	Applicant(s) ALMBERG ET AL.	
	Examiner Jacqueline F. Stephens	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/26/07.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 12-21 is/are rejected.
- 7) ☒ Claim(s) 9-11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) ☐ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) ☐ Notice of Informal Patent Application (PTO-152) |
| 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12-25-07</u> | 6) ☐ Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/31/07 have been fully considered but they are not persuasive.

Applicant argues the Examiner has not provided a basis in fact and/or technical reasoning which reasonably supports the position that what is allegedly inherent would necessarily flow from the teachings of the prior art. Applicant cites a board decision for USPN 6994698 to support this position. The Examiner will not comment on the patentability of another application. However, relative to this case, the Examiner has provided technical reasoning which supports the position of inherency. The present application is primarily directed to the joints between the belt halves and the absorbent structure. The application claims when subjected to a certain force, the longitudinal axis of the belt creates an angle, and a certain release time is attained. What structure is recited in the apparatus claims that provides the claimed release times? What factors affect the release times? Is it the force that is applied by the user, the materials used, the strength of the joint, or the angle of the belt? All of these factors presumably affect release times and all can be manipulated without changing the structure of the article. Ames does in fact cite structure and materials similar to the claimed invention, which is shown in Ames col. 5, line 34 through line 37; col. 13, line 25 through col. 14, line 20; col. 16, line 41 through col. 18, line 21; and the present applicant pages 7, paragraph 0033-0040.

Applicant repeats the argument that unlike the situation in *In Re Casey*, the claims at issue here do recite structural difference from the prior art. Applicant reiterates that claims 1, 19, and 20 clearly recite joints between each said belt half and said absorbent structure, which joints are defined such that when each belt half is subjected to a tension of 35N acting along said longitudinal axis of the belt and said longitudinal axis of the belt creates an angle (α) to said transverse axis of said absorbent structure, and the recited minimum average release times (t) of each said belt half from said absorbent structure are attained for a given angle (α). Applicant argues the aforementioned limitation sets forth a structural limitation as cited in *In re Venezia*. However, unlike the cited case, the present application does not provide substantial structural features. The present application requires relative to the belt portion "a pair of opposed belt halves comprising nonwoven material attached to said absorbent structure at said rear end region of said rear panel, each of said belt halves being attached by a respective joint, each belt half extending about a longitudinal axis of the belt such that each belt half extends outwardly from a respective longitudinal edge of the absorbent structure". No further treatment is given to the joints. Applicant states that "no every joint will meet the claimed release times", yet only a joint is claimed with no specific structure. The structure that is provided in the claims is met by the Ames reference as discussed in the rejection below. The Examiner has no reasonable way to search for Applicant's claimed properties and cannot conduct tests on the material provided in the prior art references to see if they meet the equations provided by Applicant. Since Applicant has not set forth any significant structure in the claims, the

Art Unit: 3761

Examiner must presume that a reference that meets the structural limitations that are present would inherently meet the claimed properties.

Applicant repeats the argument that the present invention would not have been obvious to one having ordinary skill in the art as shown by the Declaration submitted 9/11/06. As stated in the Office Action mailed 9/27/06, it is noted that the affiant has indicated the present invention produces unexpected results. However, the affidavit does not give specific comparative results between the present invention and the prior art. This should be presented by the factual evidence, and in the instant case the Applicant failed to show a valid side-by-side comparison between their product and the product disclosed by Ames.

Applicant repeats the argument that the lines 28 of Figure 3 of Leak are not adhesive lines, but ultrasonic bond lines. As previously stated by the Examiner, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The examiner has relied on Leak for a teaching of securing the article by plural lines of attachment.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-6 and 12-27 rejected under 35 U.S.C. 102(b) as being anticipated by or in the alternative under 35 U.S.C. 103(a) as being unpatentable over Ames et al. United States Statutory Invention Registration H1674.

As to claims 1-5, 19, 20, and 21-27, Ames discloses a belted absorbent article comprising a topsheet 24, a backsheet 26 joined to the topsheet; an absorbent core 28 positioned between the topsheet and backsheet; and a pair of opposed belt halves 62 and 64 (col. 16, lines 50-54). Ames teaches the present invention substantially as claimed except Ames does not teach the claimed release times. Even though Ames does not disclose the release times, the claims are structural claims and the belt halves of Ames have elastic capabilities and can be subjected to a tension and provide a release time from that tension. The release times are directed to an intended use of the article. Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). If the prior art structure is capable of performing the intended use, then it meets the claim limitations.

Additionally, the reference has met the structural requirements of the claims where pages 8-9, paragraph 0036 and page 11 paragraphs 0040 of the specification sets forth materials and structure suitable for forming the belt halves and attaching the belt halves to the absorbent structure. Ames teaches similar materials and structure for the belt halves (col. 16, line 41 through col. 18, line 21). Thus, Ames obviously includes belt halves capable of providing the claimed release times. The belt halves of Ames have the same properties (elasticity, attached along the longitudinal axis, extending outwardly from a longitudinal edge) and is used in the same environment as applicant's

Art Unit: 3761

outer cover (a belt in an absorbent product). When the structure recited in the reference is substantially identical to that of the claims of the instant invention, claimed properties or functions are presumed to be inherent (MPEP 2112-2112.01). A *prima facie* case of either anticipation or obviousness has been established when the reference discloses all the limitations of a claim except a property or function and the examiner can not determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof as in *In re Fitzgerald*, 619 F.2d 67, 70 205 USPQ 594, 596 (CCPA 1980). Ames further discloses a fastening system (Figures 1 and 2 and col. 20, line 46 through col. 22, line 62).

As to claim 6, see col. 16, lines 50-54.

As to claims 12 and 13, see col. 18, lines 10-21.

As to claim 14, see col. 13, lines 29-32.

As to claim 15, see col. 7, lines 10-15.

As to claim 16, see col. 7, lines 10-15; col. 13, lines 29-32; col. 18, lines 10-21.

As to claims 17 and 18, see col. 17, lines 49-55.

7. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ames et al. H1674 in view of Leak United States Patent Application Publication US 2003/0100878 A1. Ames discloses the present invention substantially as claimed. However, Ames does not disclose the joints between the belt halves and the rear region

Art Unit: 3761

comprises two spaced apart parallel lines of attachment. Leak discloses an absorbent article where the elastomeric tab is attached to the liner with spaced apart parallel adhesive lines (Figure 3). One of ordinary skill in the art would have been motivated from the teaching of Leak to provide such an attachment in Ames between the belt halves and liner. Doing so would provide an area of attachment that increases the strength of the attachment by providing plural lines of adhesive as well as allows for the elastomeric material to remain flexible by having unattached areas between the adhesive.

Allowable Subject Matter

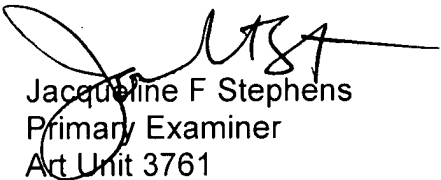
8. Claims 9, 10, and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3761

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jacqueline F Stephens
Primary Examiner
Art Unit 3761

January 7, 2008